

REMARKS

Applicant has reviewed the Office Action dated June 22, 2005 (Office Action), and the references cited therein. In response to the Office Action, reconsideration and withdrawal of the rejections in view of the following remarks is respectfully requested.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-29 are currently pending in this application.

Information Disclosure Statement

Applicant submitted a Supplemental Information Disclosure Statement and a 1449 Form on December 10, 2004 and September 3, 2004. Applicant respectfully requests that initialed copies of the 1449 Forms be returned to Applicant's Representatives to indicate that the cited references have been considered by the Examiner.

§103 Rejection of the Claims

Claims 24, 26, 28 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Comte (U.S. Patent No. 4,640,983) in view of Schaenzer (U.S. Patent No. 6,295,476). Claims 1-9, 11-14, 18-20, 22 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Comte (U.S. Patent No. 4,640,983) in view of Schaenzer (U.S. Patent No. 6,295,476) and further in view of Helland et al. (U.S. Patent No. 5,545,201). Claims 10 and 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Comte (U.S. Patent No. 4,640,983) in view of Schaenzer (U.S. Patent No. 6,295,476) and further in view of Helland et al. (U.S. Patent No. 5,545,201) and further in view of Doan (U.S. Patent No. 5,425,755) and further in view of Altman et al. (U.S. Patent No. 5,845,396). Claims 21 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Comte (U.S. Patent No. 4,640,983) in view of Schaenzer (U.S. Patent No. 6,295,476) and further in view of Helland et al. (U.S. Patent No. 5,545,201) and further in view of Altman et al. (U.S. Patent No. 5,845,396). Applicant respectfully traverses these rejections on the basis that the Office Action did not make out a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the cited reference (or references), or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)). According to *In re Lee*, “there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.” 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002)(citing *In re Fine*), *see also ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)(holding “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination”). As further stated by *In re Lee*, the “factual question of motivation is material to patentability, and [can] not be resolved on subjective belief and unknown authority.” *In re Lee* (emphasis added). “We do not ‘pick and choose among the individual elements of assorted prior art references to recreate the claimed invention,’ but rather, we look for ‘some teaching or suggestion in the references to support their use in the particular claimed combination.’” *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 U.S.P.Q.2d 1241 (Fed. Cir. 1991).

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986).

The examiner must provide a *specific reason* to support an obvious rejection. *Ex parte Humphreys*, 24 USPQ2d 1255 (BPAI 1992)(emphasis added). An examiner’s assertion that a modification proposed is “an obvious matter of engineering design choice” is an unsupported conclusion - not a reason upon which to base a rejection. *See In re Garrett*, 33 BNA PTCJ 43 (November 13, 1986); *see also In re Gal*, 980 F.2d 717, 25 USPQ2d 1076 (Fed. Cir. 1992)(rejecting an “obvious design choice” rejection wherein the claimed structure and its function are different from the prior art); *see also In re Chu*, 66 F.3d 292, 36 USPQ2d 1089 (Fed. Cir. 1995)(rejecting an “obvious design choice” rejection wherein there is no teaching or suggestion in the reference to modify its own structure in the manner of the rejected claim).

Second, the prior art reference (or references) must teach or suggest all of the claim limitations. M.P.E.P. § 2142.

Third, there must be a reasonable expectation of success. M.P.E.P. § 2142.

Claims 24, 26, 28, and 29:

Claim 24

With regard to claim 24, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer to make the specific combination that was made by Applicant, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer for the purpose of creating a method comprising “providing a second conductor . . . having a second outer filar diameter surrounded by an insulative coating such that a cross-section of the second outer filar diameter is surrounded by an insulative coating,” as recited in Applicant’s claim 24.

As submitted in Applicant’s previous communication, “an elastomer sheath [such as is recited in Comte] is not necessarily insulative – the dielectric strength of an elastomer sheath is affected by the thickness of the sheath and the presence of holes or cracks in the sheath, for example.” (Response dated June 9, 2005, p. 7). In response, the Office Action affirms that Comte “does not teach the flexible [elastomer] sheathing to be insulative,” but submits that “[i]t would have been obvious to one having ordinary skill in the art at the time of the invention to have used insulative material [as taught in Schaenzer] as the flexible sheathing around the inner conductive coil in the Comte system in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires.” (Office Action, pp. 2-3).

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom). As one example, Comte recites “[t]he wires 21, 23 belonging to a conductor 11 can either all consist of the same, electrically

conducting material or can consist of different materials [; however,] [a]t least a part of the wires [21, 23] . . . should consist of a material having, above all, good mechanical characteristics, such as a large elasticity limit, a large breaking strength or fracture resistance limit and particularly, a large endurance strength or fatigue limit . . . the wires consisting of this material should be . . . favorably elastically deformable . . . without breakage occurring.” (Comte, col. 6, lns. 7-18).

That is to say, Comte does not recite reliance on an insulative coating around the conductive coils to eliminate (conductor) fracture, but rather recites reliance on conductor wire composition and configuration. Moreover, Comte recites “[i]n an advantageous embodiment, the conductor, or each conductor, is blank [i.e., without sheathing], wherein, however, the spiral can be sheathed, at least in a partial area of its length, with an electrically insulating sheathing,” (Comte, col. 3, lns.17-21), further evidencing a lack of motivation for one skilled in the art at the time the invention was made (considering Comte) to seek out insulative coatings for the conductor(s).

Applicant further submits that Comte teaches against being combined with Schaenzer “in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires,” as recited in the Office Action, on at least two grounds. First, Comte recites “[t]he objective of the present invention is to provide a conductor device which, with the smallest possible outer diameter of the spiral, has a fatigue resistance and a relatively high electrical conductance or low electrical resistance, respectively.” (Comte, col. 2, lns. 64-68). Comte, seeking the smallest possible outer diameter of the spiral, provides no motivation to seek out insulative material to be disposed around the conductor coil(s) thereby increasing such coil diameter. Second, Comte recites “conductor devices, in which the spiral contains a core of insulating material, have relatively poor bending and expanding abilities and only a limited fatigue resistance, as well as relatively large cross-sectional dimensionings.” (Comte, col. 1, lns. 59-63).

Because Comte does not teach or suggest all of the claimed subject matter of Applicant’s claim 24, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 24. Claims 25-29 are

dependent on claim 24 and are patentable for the reasons argued above, in addition to the elements in such claims.

Claim 28

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 24-29, Applicant cannot find in Comte nor Schaenzer, either individually or in combination, all of the elements of claim 28. Notwithstanding the fact there is legally insufficient motivation to combine the references, Applicant cannot find "further comprising heat shrinking PTFE or ETFE on the second outer coil diameter and over the insulation," as recited in Applicant's claim 27 from which claim 28 depends.

Because neither Comte nor Schaenzer teaches or suggests all of the claimed subject matter of Applicant's claim 28, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) basis of rejection of claim 28.

Claim 29

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 24-29, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer to make the specific combination that was made by Applicant in claim 29, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer for the purpose of creating a method "where the first conductor includes a first outer filar diameter, and the method further comprises disposing insulation on the first outer filar diameter of the first conductor," as recited in Applicant's claim 29.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom (Office Action, pp. 2-3)). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Applicant further submits that Comte teaches against being combined with Schaenzer "in order to eliminate the untoward effects on the device of the conductors malfunctioning based

on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires,” as recited in the Office Action. (Office Action, pp. 2-3). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Because Comte does not teach or suggest all of the claimed subject matter of Applicant’s claim 29, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 29.

Claims 1-9, 11-14, 18-20, 22, and 25:

Claim 1

With regard to claim 1, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer and further with the teachings of Helland et al. to make the specific combination that was made by Applicant, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer and further with the teachings of Helland et al. for the purpose of creating a lead assembly comprising “the second conductor disposed within the first conductor, the second conductor including one or more filars having an outer filar surface having an insulative coating surrounding the outer filar surface such that a cross-section of the outer filar surface is surrounded by an insulative coating,” as recited in Applicant’s claim 1.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Applicant further submits that Comte teaches against being combined with Schaenzer “in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires,” as recited in the Office Action. (Office Action, pp. 2-

3). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Because Comte does not teach or suggest all of the claimed subject matter of Applicant's claim 1, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer and further with the subject matter of Helland et al. has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 1. Claims 2-10 are dependent on claim 1 and are patentable for the reasons argued above, in addition to the elements in such claims.

Claims 6, 7, and 9

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 1-10, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer and further with the teachings of Helland et al. to make the specific combination that was made by Applicant in claims 6, 7, and 9, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer and further with the teachings of Helland et al. for the purpose of creating a lead assembly "comprising redundant insulation disposed between the first conductor and the second conductor," as recited in Applicant's claim 6, "wherein the first conductor comprises one or more filars in a coiled configuration, and the one or more filars are coated with insulative material," as recited in Applicant's claim 7, and "comprising a coating of insulation on the first conductor," as recited in Applicant's claim 9.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Applicant further submits that Comte teaches against being combined with Schaenzer "in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure

to replace the fractured conductive wires,” as recited in the Office Action. (Office Action, pp. 2-3). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Because Comte does not teach or suggest all of the claimed subject matter of Applicant’s claims 6, 7, and 9, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer and further with the subject matter of Helland et al. has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claims 6, 7, and 9.

Claim 8

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 1-10, Applicant cannot find in Comte nor Schaenzer nor Helland et al., either individually or in combination, all of the elements of claim 8. Notwithstanding the fact there is legally insufficient motivation to combine the references, Applicant cannot find “a means for facilitating rotation of the second conductor relative to the first conductor,” as recited in Applicant’s claim 8. Rather, Helland et al. (wherein the Office Action submits the missing subject is found) recites “[t]he interconnect plug 70 may be fixed with respect to the cylindrical sheath 52, or movable if required to advance the helix 44 axially with respect to the distal end of the cylindrical sheath 52.” (Helland et al., col. 3, lns. 28-31). Applicant submits that the moving of interconnect plug 70 does not necessary require “a means for facilitating rotation of the second conductor relative to the first conductor.”

Because neither Comte nor Schaenzer nor Helland et al. teaches or suggests all of the claimed subject matter of Applicant’s claim 8, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 8.

Claim 11

With regard to claim 11, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer and further with the teachings of Helland et al. to make the specific combination that was made by Applicant, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer and further with the teachings of

Helland et al. for the purpose of creating a lead assembly comprising “the second conductor disposed within the first conductor, a coating of insulation surrounding an outer filar surface of one or more filars of the first conductor or the second conductor such that a cross-section of the outer filar surface of the first conductor or the second conductor is surrounded by an insulative coating,” as recited in Applicant’s claim 11.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Applicant further submits that Comte teaches against being combined with Schaenzer “in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires,” as recited in the Office Action. (Office Action, pp. 2-3). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Because Comte does not teach or suggest all of the claimed subject matter of Applicant’s claim 11, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer and further with the subject matter of Helland et al. has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 11. Claims 12-17 are dependent on claim 11 and are patentable for the reasons argued above, in addition to the elements in such claims.

Claim 13

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 11-17, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer and further with the teachings of Helland et al. to make the specific combination that was made by Applicant in claim 13, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer and further with the teachings of

Helland et al. for the purpose of creating a lead assembly “wherein the first conductor and the second conductor include a coating of insulative material therein,” as recited in Applicant’s claim 13.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Applicant further submits that Comte teaches against being combined with Schaenzer “in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires,” as recited in the Office Action. (Office Action, pp. 2-3). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Because Comte does not teach or suggest all of the claimed subject matter of Applicant’s claim 13, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer and further with the subject matter of Helland et al. has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 13.

Claim 14

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 11-17, Applicant cannot find in Comte nor Schaenzer nor Helland et al., either individually or in combination, all of the elements of claim 14. Notwithstanding the fact there is legally insufficient motivation to combine the references, Applicant cannot find “wherein the second conductor is rotatable relative to the first conductor,” as recited in Applicant’s claim 14. Rather, Helland et al. (wherein the Office Action submits the missing subject is found) recites “[t]he interconnect plug 70 may be fixed with respect to the cylindrical sheath 52, or movable if required to advance the helix 44 axially with respect to the distal end of the cylindrical sheath 52.” (Helland et al., col. 3, lns. 28-31). Applicant submits that the moving of interconnect plug

70 does not necessary require “the second conductor [being] rotatable relative to the first conductor.”

Because neither Comte nor Schaenzer nor Helland et al. teaches or suggests all of the claimed subject matter of Applicant’s claim 14, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 14.

Claim 18

With regard to claim 18, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer and further with the teachings of Helland et al. to make the specific combination that was made by Applicant, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer and further with the teachings of Helland et al. for the purpose of creating a method comprising “providing insulation surrounding the second outer filar diameter such that a cross-section of the outer filar diameter is surrounded by an insulative coating,” as recited in Applicant’s claim 18.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Applicant further submits that Comte teaches against being combined with Schaenzer “in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires,” as recited in the Office Action. (Office Action, pp. 2-3). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Because Comte does not teach or suggest all of the claimed subject matter of Applicant’s claim 18, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer and further with the subject matter of Helland et al. has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of

rejection of claim 18. Claims 19-23 are dependent on claim 18 and are patentable for the reasons argued above, in addition to the elements in such claims.

Claim 20

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 18-23, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer and further with the teachings of Helland et al. to make the specific combination that was made by Applicant in claim 20, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer and further with the teachings of Helland et al. for the purpose of creating a method "wherein the first conductor includes a first outer filar diameter, and the method further comprises disposing insulation on the first outer filar diameter of the first conductor," as recited in Applicant's claim 20.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Applicant further submits that Comte teaches against being combined with Schaenzer "in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires," as recited in the Office Action. (Office Action, pp. 2-3). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Because Comte does not teach or suggest all of the claimed subject matter of Applicant's claim 20, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer and further with the subject matter of Helland et al. has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 20.

Claims 10 and 15-17:

Claim 10

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 1-10, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer, further with the teachings of Helland et al., further with the teachings of Doan, and further yet with the teachings of Altman et al. to make the specific combination that was made by Applicant in claim 10, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer, further with the teachings of Helland et al., further with the teachings of Doan, and further yet with the teachings of Altman et al. for the purpose of creating a lead assembly "wherein the coating of insulation on the first conductor comprises ETFE," as recited in Applicant's claim 10.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Applicant further submits that Comte teaches against being combined with Schaenzer "in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires," as recited in the Office Action. (Office Action, pp. 2-3). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

In addition, and contrary to the position of the Office Action, Applicant cannot find in Doan any recitation of using ETFE (as recited in Applicant's claim 10) for conductor insulation. (Office Action, p. 4). Rather, Doan recites "coating the outer surface area of the conductor coil with a super thin biocompatible Teflon (polytetrafluoroethylene) [, that is, PTFE]." (Doan, col. 2, lns. 42-44).

Moreover, Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte or Schaenzer or Helland et al. or Doan) would have had no reason to consult Altman et al. as suggested by the Office Action. Notably, Altman et al. recites “[a] method for making a co-radial, multipolar coiled cable lead,” (Altman et al., Abstract), “includ[ing] a conventional passive fixation device 112.” (Altman et al., col. 5, 50-52).

Because Comte does not teach or suggest all of the claimed subject matter of Applicant’s claim 10, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer, further with the subject matter of Helland et al., further with the subject matter of Doan, and further yet with the subject matter of Altman et al. has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 10.

Claims 15-17

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 11-17, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer, further with the teachings of Helland et al., further with the teachings of Doan, and further yet with the teachings of Altman et al. to make the specific combination that was made by Applicant in claim 11, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer, further with the teachings of Helland et al., further with the teachings of Doan, and further yet with the teachings of Altman et al. for the purpose of creating a lead assembly “wherein . . . the first conductor has an outer filar diameter, and a coating of ETFE or PTFE surrounds the outer filar diameter,” as recited in Applicant’s claim 15, “wherein . . . the second conductor has an outer filar diameter, and a coating of ETFE or PTFE surrounds the outer filar diameter,” as recited in Applicant’s claim 16, and “wherein a coating of ETFE or PTFE surrounds the first outer filar diameter and the second outer filar diameter,” as recited in Applicant’s claim 17.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte) would have had no reason to consult Schaenzer as suggested by the

Office Action (i.e., in order to eliminate conductor malfunctioning based on stress and fracture and to eliminate surgical procedures resulting therefrom). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Applicant further submits that Comte teaches against being combined with Schaenzer “in order to eliminate the untoward effects on the device of the conductors malfunctioning based on stress and fracture, and in order to eliminate the potentially life threatening surgical procedure to replace the fractured conductive wires,” as recited in the Office Action. (Office Action, pp. 2-3). As one example, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 24.

Because Comte does not teach or suggest all of the claimed subject matter of Applicant’s claims 15-17, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer, further with the subject matter of Helland et al., further with the subject matter of Doan, and further yet with the subject matter of Altman et al. has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claims 15-17.

Claims 21 and 23:

Claim 21

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 18-23, Applicant cannot find any motivation, suggestion, or teaching to combine the teachings of Comte with the teachings of Schaenzer, further with the teachings of Helland et al., and further yet with the teachings of Altman et al. to make the specific combination that was made by Applicant in claim 21, as required by *In re Lee*. Specifically, Applicant cannot find in Comte any motivation, suggestion, or teaching to combine the teachings therein with the teachings of Schaenzer, further with the teachings of Helland et al., and further yet with the teachings of Altman et al. for the purpose of creating a method “further comprising disposing polyimide tubing between the first conductor and the second conductor,” as recited in Applicant’s claim 21.

Applicant submits that one having ordinary skill in the art at the time the invention was made (considering Comte or Schaenzer or Helland et al.) would have had no reason to consult Altman et al. as suggested by the Office Action. Notably, Altman et al. recites “[a] method for making a co-radial, multipolar coiled cable lead,” (Altman et al., Abstract), “includ[ing] a conventional passive fixation device 112.” (Altman et al., col. 5, 50-52).

In addition, the Office Action must provide a specific reason to support an obvious rejection, e.g., a reason which is clear and particular and not a broad conclusory statement; however, no such reason has been provided. The Office Action merely infers that substituting one known lead insulating material for another would have been an obvious alternative design choice in order to effectively insulate the conductors so electrical signals associated with the heart can be accurately sensed and delivered. (Office Action, p. 6).

Because Comte does not teach or suggest all of the claimed subject matter of Applicant’s claim 21, and no motivation, suggestion, or teaching to combine the subject matter of Comte with the subject matter of Schaenzer, further with the subject matter of Helland et al., and further yet with the subject matter of Altman et al. has been provided, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 21. Moreover, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 21 because the Office Action has not produced a specific reason to support an obvious rejection.

Claim 23

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 18-23, Applicant cannot find in Comte nor Schaenzer nor Helland et al. nor Altman et al., either individually or in combination, all of the elements of claim 23. Notwithstanding the fact there is legally insufficient motivation to combine the references, Applicant cannot find “further comprising heat shrinking PTFE or ETFE on the second outer coil diameter,” as recited in Applicant’s claim 23. Rather, Altman et al. (wherein the Office Action submits the missing subject is found) recites “thermal relaxation, can be used to reduce the residual stresses in the coating of each cable . . . [the] process involves heating the cables to just below the melting point of the coating . . . [thereby] reduce[ing] the residual stresses that the tubing or dispersion coating will have to overcome to prevent unwinding of the coiled cables.” (Altman et al., col. 3, lns. 27-

38). Applicant submits that thermal relaxation is not necessary the same as “heat shrinking PTFE or ETFE on the second outer coil diameter.”

Because neither Comte nor Schaenzer nor Helland et al. nor Altman et al. teaches or suggests all of the claimed subject matter of Applicant’s claim 23, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 23.

Claim 27:

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 24-29, Applicant cannot find in Comte nor Schaenzer nor Altman et al., either individually or in combination, all of the elements of claim 27. Notwithstanding the fact there is legally insufficient motivation to combine the references, Applicant cannot find “further comprising heat shrinking PTFE or ETFE on the second outer coil diameter and over the insulation,” as recited in Applicant’s claim 27. Rather, Altman et al. (wherein the Office Action submits the missing subject is found) recites “thermal relaxation, can be used to reduce the residual stresses in the coating of each cable . . . [the] process involves heating the cables to just below the melting point of the coating . . . [thereby] reduce[ing] the residual stresses that the tubing or dispersion coating will have to overcome to prevent unwinding of the coiled cables.” (Altman et al., col. 3, lns. 27-38). Applicant submits that thermal relaxation is not necessary the same as “heat shrinking PTFE or ETFE on the second outer coil diameter and over the insulation.”

Because neither Comte nor Schaenzer nor Altman et al. teaches or suggests all of the claimed subject matter of Applicant’s claim 27, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) basis of rejection of claim 27.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3276 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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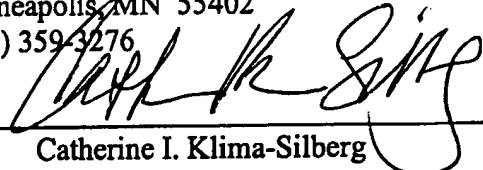
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Date

Sept. 22, 2005

By


Catherine I. Klima-Silberg

Reg. No. 40,052

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22 day of September, 2005.

Paula Suchy

Name

Paula Suchy

Signature